

REMARKS

By the present amendment, claims 10, 13, 14, 20, and 27 are amended, and claim 19 is canceled. Claims 22-26 are withdrawn and claim 21 is withdrawn-currently amended. No new matter is added by the amendment which is supported by the application and claims as originally filed including, but not limited to, original claim 7, page 11, lines 12-25 and 27-28; page 12-13, Table 1; page 14, lines 4-12; and FIG.s 2, 4, and 5. Upon entry of the present amendment, claims 10-18 and 20-29 will be pending. In view of the foregoing amendment and the following remarks, Applicants respectfully request reconsideration of this application.

As a preliminary matter, Applicants thank the Examiner for indicating that claims 27-29 are allowed.

Applicants further thank the Examiner for courtesies extended to Applicants' representative in the telephone interview of July 11, 2007. A proposed amendment and arguments were presented and discussed with respect to each of the pending rejections and the objection of claim 10. The Examiner indicated that he would reconsider the objection upon reviewing Applicants' argument. The Examiner also indicated that the proposed amendments were sufficient to overcome the 35 U.S.C. § 112, second paragraph, rejection of claims 10-17 and 19-20, as well as the 35 U.S.C. § 112, first paragraph, rejection of claims 10-18. The Examiner further indicated that the proposed amendments to the claims should be sufficient to overcome the 36 U.S.C. § 102 (e) rejection of claims 10-15 and 17-20. To avoid confusion, Applicants wish to point out that the present amendment to claim 10 is slightly different than the one discussed. The discussed amendment is now the subject of claim 13. Should the compound claims be found to be allowable, the withdrawn claims 21-26 would be subject to rejoinder; however, the Examiner did not comment on the allowability of the withdrawn claims.

I. Objection to the Claims

Applicants respectfully traverse the objection to claim 10 for reciting an alleged informality. Specifically, the Office objects that the claim recites B is one or more amino acids

or peptides, and that the recitation of “one or more amino acids” is redundant with “peptides.” Applicants disagree that there is any redundancy in the objected-to phrases.

Careful consideration of the language of claim 10 defining L in view of the specification shows the objected-to phrases to be distinct. Claim 10 recites that L, when present, may be a branched alkyl chain with at least two C-atoms. As explained in the application at page 10, line 24 to page 11, line 10, “a branched linker L provides the possibility to attach more than one peptide to the building block. In this case, the two and more functionalities B may be different or identical.” The paragraph then goes on to provide examples in which L is branched and contains two identical or different B functionalities. Thus, one could, for example, have two B functionalities, each of which is an amino acid but neither of which is a peptide. In light of such possibilities, the cited language is not redundant and Applicants respectfully request removal of the present objection.

II. Claim Rejection Under 35 U.S.C. § 112, second paragraph.

Applicants respectfully traverse the rejection of claims 10-17 and 19-20 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for reciting the phrase “might be substituted by.” As suggested by the Examiner, claim 10 is amended to recite instead “optionally substituted by.” In addition, claim 19 is canceled and thus the rejection is moot with respect to this claim. Accordingly, Applicants respectfully submit that as amended, claim 10 is clear as written and request withdrawal of the present rejection of claims 10-17 and 20.

III. Rejections Under 35 U.S.C. § 112, first paragraph

Applicants respectfully traverse the rejection of claims 10-18 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office asserts that the specification does not disclose a sufficient number examples of “a functionality for attachment to a solid support or a functionality comprising the solid support” to provide adequate written description for the cited claims. While Applicants disagree with this assessment, solely to expedite prosecution, Applicants have amended claim 10 to recite the

elements of claim 19 and canceled claim 19. Because claim 10 now recites a specific functionality for attachment to a solid support, or a functionality comprising the solid support, Applicants submit that the present rejection is overcome and respectfully request that it be removed.

IV. Rejections Under 35 U.S.C. § 102

Applicants respectfully traverse the rejection of claims 10-15 and 17-20 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,448,058 (the '058 patent). The Office bases the present rejection on two sulfur containing compounds disclosed at col. 9, line 47 – col. 10, line 65 of the cited reference. By the present amendment, Applicants have deleted SH and protected SH from the definition of the variable C.

In view thereof, Applicants submit that the cited reference neither teaches nor suggests the claimed compounds as defined by claim 10. Specifically, the compounds of claim 10 lack the protected sulfur group found in the cited compounds. Furthermore, the use of sulfur, which is imperative for the inhibitory activity of compounds of the cited reference towards metalloproteases, fails to suggest the use of nitrogen, oxygen or carbonyl in place thereof. As is well known to the skilled artisan, nitrogen, oxygen and carbonyl groups have different chemical properties and reactivities compared to sulfur, and the use of sulfur in the cited art cannot fairly suggest nitrogen, oxygen or carbonyl in the presently claimed invention. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn.

V. Unelected Subject Matter

Applicants respectfully request that the unelected subject matter of claims 21-26 be rejoined according to Patent Office procedure. As set forth in M.P.E.P. § 821.04, where a product claim is patentable, a process claim that includes all the limitations of the allowed compound must be entered as a matter of right. Applicants note that claims 21-26 depend directly or indirectly from product claim 10 and therefore include all the limitations of claim 10.

Applicants submit that in view of the present amendment and remarks, claim 10 is patentable and therefore request that the subject matter of claims 21-26 be rejoined for examination.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. If any issues remain to be resolved in view of the present response, the Examiner is invited to contact the undersigned by telephone so that a prompt disposition of the present application may be achieved.

Respectfully submitted,

Date August 10, 2007

By Joseph P. Meara

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4303
Facsimile: (608) 258-4258

Joseph P. Meara
Attorney for Applicant
Registration No. 44,932